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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,811	02/04/2002	Thomas E. Ward III	IS/074 Cont. 4	6065
75563 7590 07/07/2010 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704				
EXAMINER PENG, FRED H				
ART UNIT 2426		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/066,811

**Applicant(s)**

WARD ET AL.

**Examiner**

FRED PENG

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26, 31-58 and 60-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 31-58 and 60-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/26/2010 has been entered.

**DETAILED ACTION**

***Status of Claims***

2. Claims 1-26, 31-58 and 60-65 are pending in this application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23, 26, 31-58 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) in view of Ellis et al (US 2008/0184315).

Regarding Claims 1, 39 and 57, Schein discloses a system (FIG.1, FIG.16A) with corresponding method and a computer readable medium (FIG.1, 18) having stored thereon a set of instructions for displaying an advertisement (FIG.16A, 524, 526, 528), when executed by a microprocessor (FIG.1, 16), cause the microprocessor to perform the step of:

storing, local to a user equipment, viewer profile information in a first database (Para 109; viewing history);

receiving advertisement information and stored in second database; the advertisement including primary advertisement information; a processor configured to retrieve the stored advertisement from the second database and display the advertisement (Para 7 lines 1-5; Para 50; such as a broadcast commercial).

Schein is silent about determining, based on the retrieved advertisement and the stored viewer profile information, supplemental advertisement information; and

customize, local to the user equipment, the retrieved advertisement to include the supplemental advertisement information to form a customized advertisement; and a display screen configured to display the customized advertisement, wherein the displayed customized advertisement includes both the primary and the supplemental advertisement information.

In an analogous art, Ellis discloses in a preferred embodiment, the currently-tuned television signal comprises a commercial advertisement and the product or service available is associated with the commercial. ... For example, in the simplest embodiment, only a single product, i.e., a product brochure, may be available. In this case, the microcontroller 16 may be configured to cause the video overlay device 25 to display a standard on-screen message such as "Press \* to receive a brochure describing this product." This embodiment assumes that the user has previously provided his name and address or that the information is extracted from the program services billing system (Para 230).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include supplemental advertisement information, as taught by Ellis, to take advantage of targeting the specific viewers; thereby improve advertising effectiveness.

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Regarding Claim 2, Schein in view of Ellis disclose the receiving, determining, customizing, and displaying steps are performed in substantially real time (Para 230; customize the broadcast commercial is substantially real time).

Regarding Claims 3, 13, 14 and 49-50, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claims 4, 5 and 40-42, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129, Para 133 lines 21-25).

Regarding Claims 6 and 43, Schein discloses storing favor program guide information and respective advertisements for display. Therefore, Schein inherently discloses combining a portion of the received advertisement with stored favor channel information (FIG.16A, 524, 528; Para 109-111; as the favor program guide including the corresponding favorite channels and programs such as a guide shown in FIG.16A).

Regarding Claims 7 and 44, Schein further discloses storing a favor program information and combining a portion of the received advertisement with stored favor program information (FIG.16A, 524, 528; Para 109-111, especially Para 109 lines 1-7; user is able to customize a favorite program list with advertisement such as a guide shown in FIG.16A).

Regarding Claims 8, 16, 45 and 52, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11, Para 144 lines 8-12).

Regarding Claims 9 and 46, Ellis further discloses storing an info related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location (Para 230, a viewer's address).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include advertisement with the info related to a geographical location, as taught by Ellis to target individual viewers.

Regarding Claims 10 and 47, Schein further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Para 128).

Regarding Claims 11, 12 and 48, Schein also discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

Regarding Claims 15, 17, 51 and 53, Schein further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info and display more detail info related to the selected info and selected advertisement (FIG.1, 40; Para 95; Para 133).

Regarding Claims 18, 19 and 54, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (FIG.11, 230; FIG.18A; FIG.19A; Para 96).

Regarding Claims 20 and 58, Ellis further discloses overlaying, at a user equipment, the supplemental advertisement information onto the retrieved advertisement to form a customized

advertisement and displaying the customized advertisement on the display, wherein the customized advertisement includes both the primary advertisement information and the overlaid supplemental advertisement information (Para 230; especially lines 22-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to overlay the supplemental advertisement information, as taught by Ellis, to take advantage of targeting the specific viewers; thereby improve advertising effectiveness.

Regarding Claims 21-23, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129; Para 133 lines 21-25).

Regarding Claims 26 and 34, Ellis teaches overlaying an icon to access the products for more information (Para 230). Using of an icon to link to a web site to get more information such as product is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to a link to a web site, to take advantage of internet technology to access more information.

Regarding Claims 31 and 32, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claim 33, Schein further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (FIG.1, 40).

Regarding Claim 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

Regarding Claim 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para 133 lines 21-26).

Regarding Claim 37, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (Para 96).

Regarding Claim 38, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 55, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 56, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129, Para 133 lines 21-23).

Regarding Claims 62, Schein in view of Ellis discloses the customized advertisement is displayed on a first portion of the display (FIG. 16A, 524, 526 or 528 for customized advertisement) and television schedule information is displayed on a second, non-overlapping, portion of the display (FIG. 16A, 508; program matrix of cells including program schedule information).

Regarding Claims 63, Schein in view of Ellis discloses the customized advertisement is displayed on a first portion of the display (FIG. 16A, 524, 526 or 528 for customized



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advertisement) and a video is displayed on a second, non-overlapping, portion of the display (FIG. 16A, 526; to display the selected program).

Regarding Claims 64, in one embodiment, Ellis discloses the primary advertisement information is displayed on a first portion of the display (FIG. 9, HBO program Shaker Run), and the supplemental advertisement information is displayed on a second, non-overlapping, portion of the display (FIG. 9, HBO order message). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the primary advertisement information in one portion and the supplemental information in another portion as an engineering choice.

Regarding Claims 65, Ellis discloses the primary advertisement information is displayed on a first portion of the display, and the supplemental advertisement information is displayed on a second portion of the display; wherein the second portion of the display overlaps at least partially with the first portion of the display (Para 230; the supplemental advertisement information in one portion of the display overlays the primary advertisement in another portion of the display). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to overlay the supplemental advertisement information over the primary advertisement information as an engineering choice.

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 20 above, and further in view of Coleman et al (US 5,844,620).

Regarding Claims 24 and 25, Schein discloses storing and displaying a favor program listing but is silent about overlaying the stored favor channel/program information onto a portion of the stored advertisement information.

In an analogous art, Coleman discloses overlaying the stored program guide information onto a portion of a programming which could be an advertisement to search for new channels or programs (FIG.6; Col 5 lines 22-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Schein and Ellis to include overlaying the stored favor channel/program listing onto a portion of the stored advertisement information, without interruption of existing programming while look for favor new channels/programs.

5. Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 1 above, and further in view of Esch et al (US 5,099,319).

Regarding Claim 60, Esch discloses allowing customized television commercials by adding text in any language (Col 3 lines 45-51). Therefore, a person of ordinary skill in the art would have had good reason to pursue the known options to replace the original text with customized text to target the certain group. It would require no more than "ordinary skill and common sense," to replace the original text with customized text to achieve targeting purpose.

Regarding Claim 61, Esch also discloses adding graphics to customize a commercial (Col 3 lines 45-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace a graphical portion of the received advertisement information with a graphic portion of the supplemental advertisement information to take advantage of graphical form to customize an advertisement for targeted group as an engineering choice or known options to try as common sense.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-26, 31-58 and 60-65 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Claims 1-26, 31-58 and 60-65 are rejected.

***Correspondence Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:30-19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fred Peng/

Examiner, Art Unit 2426

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/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

July 6, 2010